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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/206,249 12/07/98 SEIBERG

M JBP438

EXAMINER

HM12/0511

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MELLER, M

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

05/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/206,249

Applicant(s)

Seiberg et al.

Examiner

Michael Meller

Group Art Unit

1651

☒ Responsive to communication(s) filed on Apr 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-69 is/are pending in the application.

Of the above, claim(s) 1, 3, 5-7, 23, 25-27, 37, 39, 41-43, 48-57, and 59-6 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2, 4, 8-22, 24, 28-36, 38, 40, 44-47, and 58 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group II, claims 2, 4, 8-22, 24, 28-36, 38, 40, 44-47 and 58 and the election of species of soybean derivative (Andrea Colby elected on the phone 5/3/2000, the specific soybean derivative, soybean milk), keratinocytes and skin disorders as their elected species in Paper No. 5 is acknowledged. The traversal is on the ground(s) that searching all of the groups of the restriction requirement would not unduly burden the resources of the Patent Office. This is not found persuasive because as noted by the different classifications of the groups and due to the extensive literature search involved in searching the groups which is not co-extensive searching the other groups would in fact be a burden on the Patent Office.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 2, 4, 8-21, 24, 28-35, 38, 40, and 44-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Limtrakul et al. (See abstract)

The elected species of the claims reads on soybean milk used to treat skin disorders.

The reference teaches that soybean milk can be used to treat a tumor on mouse skin.

4. Claims 2, 4, 8-22, 24, 28-36, 38, 40, 44-47 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagiwara et al. (See col. 1, line 50, col. 2, line 45-46, col. 4, line 46, and col. 5, line 36-37), Kosaka (see col. 2, line 5-6, lines 32-49), JP 62036304 (see abstract), JP 408143442A (see abstract), or JP 08143442A (see abstract).

The elected species of the claims reads on soybean milk used to treat skin disorders.

The references each teach using soybean milk to treat skin disorders.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2, 4, 8-22, 24, 28-36, 38, 40, 44-47 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Limtrakul et al. (Limtrakul) taken with Kosaka, (see col. 2, line 5-6, lines 32-49), JP 62036304 (see abstract), JP 408143442A (see abstract), or JP 08143442A (see abstract).

The claims are drawn to the elected species composition (soybean milk and a pharmaceutical or cosmetically acceptable carrier) and method of using the composition to treat skin disorders.

Limtrakul teaches using soybean milk to treat a skin disorder, namely a tumor growing on the skin, see abstract.

The reference does not teach using the soybean milk on a human.

The secondary references each teach using soybean milk on human skin to treat a skin disorder.

Thus, it would have been obvious to one of ordinary skill in the art to treat a human with the composition of Limtrakul when Limtrakul was taken with the secondary references which teach that human skin can be treated with soybean milk to treat skin disorders.

Therefore, the claimed subject matter is *prima facie* obvious.

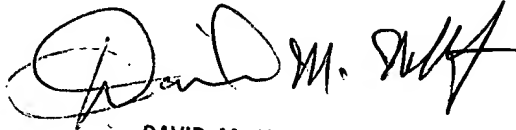
Any inquiries concerning this communication should be directed to Examiner Mike Meller at telephone number (703) 308-4230. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Wityshyn, can be reached at (703) 308-4743.

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The Fax phone number for the art unit is (703) 308- 0294. Any inquiries of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


DAVID M. NAFF
PRIMARY EXAMINER
ART UNIT 1651